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In re Application of
MOHAMMED et al.
Application No.: 10/566,933
PCT No.: PCT/US04/25124
Int. Filing Date: 2 August 2004
Priority Date: 01 August 2003
Attorney Docket No.: 27347-518NATL
For: ARRAYS, METHODS AND KITS FOR
PREPARATION AND USE OF SYNTENIC
GENOMIC ARRAYS FOR DIAGNOSTICS AND
TOXICOLOGY

DECISION ON REQUEST

UNDER 37 CFR 1.47(b)

This is a decision on applicant's "Petition under 37 CFR 1.47(b)", filed on 26 September 2007 in the United States Patent and Trademark Office (USPTO). Petitioner seeks to delete all inventors as inventors in the above referenced application and to add four different inventive entities as inventors.

BACKGROUND

On 01 February 2006, applicant filed a Transmittal Letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371 with, *inter alia*, the requisite basic national fee.

On 26 February 2007, a Notification of Missing Requirements was mailed to applicant indicating that an oath or declaration, in compliance with 37 CFR 1.497(a) & (b), was required.

On 26 September 2007, applicant filed a petition under 37 CFR 1.47(b) and 1.497(d) for correction of inventorship to delete inventors erroneously named in the international application.

DISCUSSION

Petitioner states that Robert C. Johnson, Mansoor Mohammed, Jae Weon Kim and Xan-Yan Lu were erroneously named as inventors in PCT/US04/25124, now national stage application 10/566,933. Petitioner states that the correct inventors are Linda M. Sargent, Steven H. Reynolds, David T. Lowry and Michael L. Kashon and submitted an executed declaration identifying them as inventors for PCT/US/25124.

Where the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and 37 CFR 1.497(d)

names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added or deleted as an inventor that any error in inventorship occurred without deceptive intention on his or her part; (2) the fee set forth in § 1.17(i); and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee(s).

The processing fee of \$130.00 has been paid, satisfying Item (2) above.

With regard to Item (3), consent of the assignee to the deletion of the inventors has been submitted. However the consent does not identify the inventors who will be added. Thus, Item (3) above is not satisfied.

With respect to Item (1) above, the published International application named Robert C. Johnson, Mansoor Mohammed, Jae Weon Kim and Xan-Yan Lu as inventors. Applicants provided a statement signed by Robert C. Johnson that there was no deceptive intent on his part in including him as an inventor. Petitioner also submitted statements from Linda Sargent, Steven H. Reynolds, David T. Lowry and Michael L. Kashon added as joint inventors indicating that each of these respective inventors was omitted without deceptive intent from the above-captioned application.

The published International application also named Mansoor Mohammed, Jae Weon Kim and Xan-Yan Lu as co-inventors. The petition was not accompanied by statements from Mansoor Mohammed, Jae Weon Kim and Xan-Yan Lu requesting deletion of their inventorship. Moreover, there is no communication from the International Bureau (that is, Form IB/306) indicating that Mansoor Mohammed, Jae Weon Kim and Xan-Yan Lu were removed as an applicant/inventor under PCT Rule 92*bis* during the international phase.

Accordingly, applicant has not met all of the requirements to remove Mansoor Mohammed, Jae Weon Kim and Xan-Yan Lu as co-inventors in the above-identified international application. Mansoor Mohammed, Jae Weon Kim and Xan-Yan Lu remain inventors for the above referenced application and therefore, a declaration or oath, in compliance with 37 CFR 1.497(a) and (b) is required to fulfill the requirements of 35 U.S.C. 371(c).

In the alternative, a renewed petition is necessary, providing either the Form IB/306 noting the removal of Mansoor Mohammed, Jae Weon Kim and Xan-Yan Lu as inventors or a statements of Mansoor Mohammed, Jae Weon Kim and Xan-Yan Lu requesting their deletion as inventors.

Petitioner is advised that a petition under 37 CFR 1.47(b) is not available with respect to the lack of a statement under 37 CFR 1.497(d)(1). See MPEP 1893.01(c). Thus, the petition under 37 CFR 1.47(b) is dismissed.

Petitioner is also advised that a copy of the decision is being mailed to the law firm of KLARQUIST SPARKMAN as a courtesy as a power of attorney from the inventors of record has not been submitted.

CONCLUSION

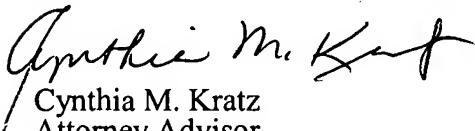
For the reasons discussed above, the submission under 37 CFR 1.497(d) to all inventors is **DISMISSED WITHOUT PREJUDICE**. The petition under 37 CFR 1.47(b) is dismissed.

Any reconsideration on the merits of the petition under 37 CFR §1.497(d) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request

should include a cover letter entitled "Renewed Petition Under 37 CFR §1.497(d)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

The renewed petition should provide either: a copy of the Form IB/306 regarding the International Bureau's removal of the inventors or the appropriate statement from the inventors requesting their deletion as a named inventor.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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